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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,677	08/16/2001	Donald F. Weaver	NCI-006DV1	5945

959 7590 04/28/2004

LAHIVE & COCKFIELD, LLP.
28 STATE STREET
BOSTON, MA 02109

EXAMINER

RAO, DEEPAK R

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/932,677	Applicant(s) WEAVER ET AL.	
	Examiner Deepak R Rao	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply




A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 68, 138 and 142-186  are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 68, 138, 142 and 145  are rejected.
- 7) ☒ Claim(s) 143, 144 and 146-186  are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11504</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This office action is in response to the communication filed on March 30, 2004.

Claims 68, 138 and 142-186 are pending in this application.

Upon reconsideration, the finality of the previous office action has been withdrawn in view of the following rejections under new grounds.

The following rejections are withdrawn:

The terminal disclaimer filed on March 30, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,306,909 has been reviewed and is accepted. The terminal disclaimer has been recorded. The obviousness-type double patenting rejection is hereby withdrawn in view of the terminal disclaimer.

The obviousness-type double patenting rejection over copending application S.No. 09/932,676 is hereby withdrawn in view of applicant's remarks.

The following rejections are under new grounds:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 68, 138, 142 and 145 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abdul-Ghani et al., Brain Research (1996). The reference teaches the use of an 3-aminopropylarsonate compound that is analogous to compounds involved in the instant method of use, see the reference article, especially the abstract. The compound is taught to be useful as antiepileptogenic and as having anti-convulsant activity. The instant claims differ from the reference claims by having a two carbon spacer group separating the amino group and the anionic group as compared to the reference compound wherein there is a three carbon spacer. Therefore, the compound encompassed by the instant method is a homolog of the reference disclosed compound, i.e., differs by a $-CH_2-$ group. One having ordinary skill in the art would have been motivated to use a compound which is analogous to the reference disclosed anti-convulsant compound because such structurally analogous compounds would be expected to possess similar utilities. It has been held that compounds that are structurally homologous or isomeric to prior art compounds are prima facie obvious, absent a showing of unexpected results. *In re Haas*, 60 USPQ 544 (CCPA 1944); *In re Henze*, 85 USPQ 261 (CCPA 1950). It has been

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long established that structural relationship varying the size of a linking carbon chain - is per se obvious. Specifically, *In re Coes*, 81 USPQ 369 have a C₁ link unpatentable over a C₂ link.

Allowable Subject Matter

Claims 143-144 and 146-186 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Receipt is acknowledged of the Information Disclosure Statement filed on January 15, 2004 and a copy is enclosed herewith. Receipt is also acknowledged of the International Search Report of PCT/CA02/00363 and the cited documents have been fully considered.

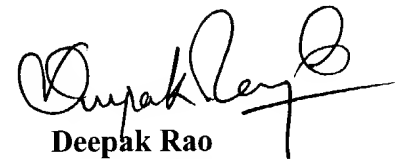
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (571) 272-0672. The examiner can normally be reached on Tuesday-Friday from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mukund Shah, can be reached on (571) 262-0674. If you are unable to reach Dr. Shah within a 24 hour period, please contact James O. Wilson, Acting-SPE of 1624 at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

A handwritten signature in black ink, appearing to read 'Deepak Rao', with a stylized flourish extending from the end.

Deepak Rao
Primary Examiner
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April 22, 2004